

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Takuya Tamatani et al.	Art Unit :	1644
Patent No. :	7,247,612	Examiner :	Ilia I. Ouspenski
Issue Date :	July 24, 2007	Conf. No. :	3400
Serial No. :	10/723,602		
Filed :	November 25, 2003		
Title :	METHODS OF TREATING AN INFLAMMATORY DISEASE WITH A JTT-1 POLYPEPTIDE		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. This application is being filed together with a petition under 37 C.F.R. § 1.183 for a suspension of the two month time limit specified under 37 C.F.R. § 1.705(d).

Reconsideration of the final PTA calculation to increase total PTA from 451 to 692 days, is respectfully requested. The term of the patent is subject to the terminal disclaimers referenced herein.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a

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“B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before January 25, 2005 (the date that is fourteen months after November 25, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on April 27, 2006, thereby according a PTO Delay of 457 days. Patentee does not dispute the PTO's calculation for this “A Delay” from January 26, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to April 27, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 457 days.

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“B Delay”

The period beginning on November 26, 2006 (the day after the date that is three years after the date on which the application was filed), and ending July 24, 2007 (the date the patent was issued), is 241 days in length.

In view of the period of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 241 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 241 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of “A Delay” and “B Delay”

As detailed above, “A Delay” accumulated during the following period:

January 26, 2005, to April 27, 2006.

As detailed above, “B Delay” accumulated during the following period:

November 26, 2006, to July 24, 2007.

The “A Delay” and the “B Delay” overlap (i.e., occur on the same calendar day) for a total of 0 days.

Applicant Delay

A reply to an Office Action was due on or before October 31, 2006 (the date that is three months after July 31, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on November 6, 2006, thereby according an Applicant Delay of 6 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from November 1, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to November 6, 2006. See 37 C.F.R. § 1.704(b).

In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 6 days.

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Terminal Disclaimer

This patent is subject to terminal disclaimers. The Assignee has disclaimed the terminal portion of the term of the patent subsequent to the expiration dates of each of the following patents:

U.S. Patent No. 7,259,147;
U.S. Patent No. 7,226,909; and
U.S. Patent No. 7,217,792.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 451 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 698 days (i.e., the sum of 457 days of "A Delay" and 241 days of "B Delay" minus the 0 days of overlap);
- 2) Total Applicant Delay should be calculated as 6 days; and
- 3) Total PTA should be calculated as 692 days. The term of the patent is subject to the terminal disclaimers referenced herein.

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Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket Number 14539-0004011.

Respectfully submitted,

Date: January 22, 2009

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